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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1944.

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No. .....

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LINE MATERIAL COMPANY AND WILLIAM O. SCHULTZ,

*Petitioners,*

*vs.*

CONWAY P. COE, COMMISSIONER OF PATENTS,

*Respondent.*

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## PETITION OF LINE MATERIAL COMPANY AND WILLIAM O. SCHULTZ FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

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*To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:*

Your petitioners, Line Material Company and William O. Schultz, respectfully pray for a writ of certiorari to the United States Court of Appeals for the District of Columbia to review the judgment of that court entered on the 10th day of July, 1944 (petition for rehearing denied August 12, 1944). A transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in accordance with the rules of this Court.

**Summary and Short Statement of the Matter Involved.**

1. On May 24, 1934, petitioner, William O. Schultz, filed an application for a patent for an electrical fuse construction which received Serial No. 727,450,[1] and which was assigned to petitioner, Line Material Company.[2]

2. Petitioners sought a patent on this application to cover the invention thereof as defined in claims 46, 48 and 49 of said application.[3]

3. On March 11, 1942, the Board of Appeals refused a patent on this application as to said claims, ruling that such claims were not supported by the disclosure in the application.[4]

4. Petitioners did not take an appeal to the United States Court of Customs and Patent Appeals but exercised the alternative remedy provided for by Section 4915 of the revised Statutes (U. S. C. Title 35, Sec. 63)[5] by filing thereunder, on August 3, 1942, a timely bill in equity in the United States District Court for the District of Columbia.[6]

5. The defendant below admitted in its answer that your petitioner, William O. Schultz, is the first inventor of the inventions disclosed in his application and was the senior party in a previously terminated Patent Office interference proceeding.[7]

6. A trial was had on the merits, the defendant offering no evidence other than the Patent Office record, and, on January 18, 1943, the District Court entered judgment on

1. Rec. p. 3, par. 6.
2. Rec. p. 3, par. 7.
3. Rec. p. 3, par. 9.
4. Rec. pp. 122-124.
5. Rec. p. 7, par. 24.
6. Rec. p. 2.
7. Rec. p. 9. The complaint so alleged (Pars. 5, 6 and 10; Rec. pp. 2, 3 and 4). These allegations were admitted (Ans. par. 1, Rec. p. 9).

the merits and dismissed petitioners' complaint,[8] from which, on February 16, 1943, an appeal was taken to the United States Court of Appeals for the District of Columbia.[9]

7. The Court of Appeals, in a decision dated July 10, 1944, under the authority of *Hoover Co.* v. *Coe*, 62 U. S. P. Q. 115[10] (decided the same day), affirmed the lower court's dismissal of the complaint.[11]

8. The material facts with respect to this application upon which the Court of Appeals based its decision of lack of jurisdiction are as follows:

(a) Before the Board of Appeals, on March 11, 1942,[12] refused a patent on this application, the claims sought were placed in interference proceedings by the Patent Office in which petitioner, William O. Schultz, was the senior party.[13]

(b) On motion of rival applicants, the interference proceedings were dissolved by the Patent Office upon the ground that no interference in fact existed because the claims were not supported by the disclosure of petitioners' application.[14] This application was thereupon remanded to the Examiner for *ex parte* prosecution[15] leading up to the aforesaid decision of the Board of Appeals on which the suit herein was based.

(c) The District Court rendered an opinion, findings of fact and conclusions of law, and a judgment dismissing the bill,[16] it being the position of the court that the ruling of the Patent Office was a correct one.

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8. Rec. p. 16.

9. Rec. p. 17.

10. This *Hoover Co.* v. *Coe* decision is set out in the Appendix page 27. This Court granted certiorari in this *Hoover Co.* case and the same is now pending before this Court as No. 486.

11. Rec. p. 129.

12. Rec. p. 124.

13. Rec. p. 4, par. 10.

14. Rec. p. 5, par. 12.

15. Rec. p. 5, par. 15.

16. Rec. pp. 13-16.

(d) The Court of Appeals in its decision[16a] affirmed the dismissal of the complaint on the authority of the *Hoover* case, *supra*, and held that the court did not have jurisdiction of the subject matter here because it assumed that further proceedings in the Patent Office might hereafter be necessary as to the claims in suit, and that for this reason the decision of the Board of Appeals did not possess such finality as to qualify your petitioners to proceed under Section 4915 R. S.

## Jurisdiction.

The basis upon which it is contended that this Court has jurisdiction to review the judgment in question is:

1. The judgment was rendered in a civil action brought under the patent statutes to secure an adjudication that petitioners are entitled, according to law, to receive a patent for their invention, as specified in their claims 46, 48 and 49.

2. The Court of Appeals for the District of Columbia has decided a question of general importance and a question of substance relating to the construction or application of Sec. 4915 of the Revised Statutes,[17] which has not been, but should be, settled by this Court.

3. The date of the judgment to be reviewed is July 10, 1944; petition for rehearing denied August 12, 1944.

4. The statute under which jurisdiction is invoked is 240(a) of the Judicial Code, 28 U. S. C. A. 347, as amended by the Act of February 13, 1925.

5. Cases believed to sustain jurisdiction are:

*Durham* v. *Seymour*, 161 U. S. 235;
*Morgan* v. *Daniels*, 153 U. S. 120;
*Hill* v. *Wooster*, 132 U. S. 693;
*Gandy* v. *Marble*, 122 U. S. 432.

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16a. See footnotes 10 and 11, *supra*.

17. Appendix p. 33.

## Questions Presented.

From the foregoing statement of facts of the case the following questions are presented:

1. Where the jurisdictional facts necessary to the maintenance of a suit by an applicant for patent under Section 4915 R. S. are admitted to exist, can a Federal Court properly dismiss the suit for want of jurisdiction on the mere conjectural supposition that if the Patent Office decision refusing the patent is reversed, a subsequent proceeding in the Patent Office may arise which might defeat issuance of a patent to the applicant, and notwithstanding the established practice of the courts to the contrary?

2. In a suit under Section 4915 R. S., brought by a senior applicant for a patent, who, subsequent to a dissolution of a previous Patent Office inter-party interference proceeding, was finally refused a patent by the Patent Office Board of Appeals in an *ex parte* proceeding, can the court on its own motion dismiss the suit for want of jurisdiction because of the mere likelihood of a further conflict with an adversely owned patent issued since the interference, even though such a dismissal contravenes the spirit and intent of Patent Office Rule 116[18] and the provisions of Section 4918 R. S.?[19]

3. Where the uncontroverted evidence shows that the disclosure of the application is sufficient to teach those skilled in the art how to make and use the invention defined in the claims here sought, may a Federal Court refuse an applicant his remedy under Section 4915 on the sole basis of the Patent Office record?

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18. Appendix p. 35.
19. Appendix p. 35.

**Reasons Relied Upon for a Grant of a Writ of Certiorari.**

The discretionary power of this Court is invoked upon the following grounds:

1. A petition for writ of certiorari was granted by this Court in the case of *The Hoover Company* v. *Conway P. Coe, Commissioner of Patents,* pending in this Court as No. 486, involving substantially the same questions presented by this petition.

2. The Court of Appeals for the District of Columbia, in deciding that a Federal Court has no jurisdiction of a bill in equity under Section 4915 of the Revised Statutes, where the jurisdictional facts are admittedly established, decided an important question of Federal law in a manner which is in derogation of the public interest and contrary to public policy declared by Congress. The decision of the Court below is contrary to the long standing construction given Section 4915 by this Court, by other Circuit Courts of Appeals and by the Patent Office, and even by the same Court of Appeals.

3. The judgment and opinion below in this case and in the *Hoover* case, *supra,* has created such confusion on the question of when a Federal Court does or does not have jurisdiction of bills in equity against the Commissioner of Patents under Section 4915 as to leave in doubt the true meaning of the statute and appropriate procedure thereunder because it is in direct conflict with the prior decisions of the same court in *Tomlinson of High Point* v. *Coe,* 123 F. (2d) 65, and in other cases,[20] and with the simultaneous decision of the same court in *Minnesota Mining Co.* v. *Coe,* 125 App. D. C. ..... ..., 62 U. S. P. Q. 119. Therefore the judgment and opinion below might seriously hinder future administration of the law under this statute.

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20. Examples are cited in footnote p. 20.

4. The Court of Appeals for the District of Columbia, in holding that the District Court lost jurisdiction of this action in spite of the fact that the jurisdictional facts admittedly exist, has extended the doctrine of *The Hoover Co.* v. *Coe*, 125 App. D. C. ....., 62 U. S. P. Q. 115, to a further illogical extreme which will have the immediate effect of increasing instances where Federal Courts will believe themselves deprived of the power or relieved of the public duty of passing upon the right of applicants to receive patents according to law in cases clearly falling within the provisions of Section 4915. The importance of this question, from the viewpoint of public policy, requires the prompt scrutiny and clarification of this Court before it is allowed to become established as a new precedent.

5. In holding that it would be impossible to decide this case in petitioners' favor because the question depends upon whether they had priority over the parties to the dissolved interference who are not before the court, the Court of Appeals in effect held that such parties should have been brought before the court so that the issue of priority might be determined and thus construed Section 4904 of the Revised Statutes contrary to the construction placed upon it by this Court.

6. The decision of the court below further contravenes the spirit and intent of Patent Office Rule 116 applicable to a senior applicant of a dissolved Patent Office interference as well as the spirit and intent of Section 4918 of the Revised Statutes which provides for a remedy should your petitioner be granted a patent in conflict with another patent which might have been granted to a party in the previous interference.

7. The decision of the court below is contrary to the spirit and intent of Section 4915 R. S. and the weight of the decisions interpreting same.

Wherefore, your petitioners respectfully pray that a writ of certiorari issue out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding said court to certify and send to this Court, on a date to be designated, a full transcript of the record and full proceedings had in this case, to the end that this case may be reviewed and determined by this Court as to the questions presented hereby as well as to the question of whether petitioners are entitled, according to law, to receive a patent for their said invention, and that the judgment of the courts below be reversed, and that these petitioners may be granted such other and further relief as may seem proper.

Respectfully submitted,

CHARLES F. MERONI,
CARLTON HILL,
*Counsel for Petitioners.*

WILLIAM A. SMITH, JR.,
SAMUEL W. KIPNIS,
*Of Counsel.*

Dated: Chicago, Illinois,
November 8, 1944.

## BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

### Opinions of the Courts Below.

The opinion of the District Court is not reported, but is reproduced beginning at page 12 of the Record.

The opinion of the Court of Appeals for the District of Columbia is reported in 62 U. S. P. Q. 120 and is reproduced beginning at page 129 of the Record.

### Jurisdiction.

The grounds for jurisdiction are:

1. The date of the judgment to be reviewed is July 10, 1944; petition for rehearing denied August 12, 1944.

2. The judgment was rendered in a civil action brought under the patent statutes to secure an adjudication that petitioners are entitled, according to law, to receive a patent for their invention, as specified in their claims 46, 48 and 49.

3. The statute under which jurisdiction is invoked is 240(a) of the Judicial Code, 28 U. S. C. A. 347, as amended by the Act of February 13, 1925.

4. Cases believed to sustain jurisdiction are:

*Durham* v. *Seymour*, 161 U. S. 235;
*Morgan* v. *Daniels*, 153 U. S. 120;
*Hill* v. *Wooster*, 132 U. S. 693;
*Gandy* v. *Marble*, 122 U. S. 432.

## Statement of the Case.

1. On August 3, 1942, petitioners filed their bill in equity under Section 4915 R. S. in the United States District Court for the District of Columbia seeking the remedy provided in that statute[21]. The complaint was based upon the refusal of a patent by the Patent Office Board of Appeals on petitioners' application, as specified in their claims 46, 48 and 49[22].

2. Following a trial, upon the merits, the District Court dismissed the complaint[23]. Petitioners appealed to the Court of Appeals for the District of Columbia[24]. In an opinion dated July 10, 1944, the Court of Appeals held that the doctrine of *Hoover & Co.* v. *Coe.*, 62 U. S. P. Q. 115[25], applied and that the District Court lacked jurisdiction[26].

3. The basis of the decision of the Court of Appeals was that it appeared from the record that before a patent was refused by the Board of Appeals, petitioners' application was involved in interferences which were dissolved on motion of rival applicants upon the ground that said claims 46, 48 and 49 were not supported by petitioners' application. The rationale of the court below was that a decision could not be made in applicants' favor because to do so would have the effect of reversing the Patent Office ruling of no interference and that, even if the court felt so inclined, it could not make a decision in applicant's

(21) Rec. p. 2.

(22) Rec. pp. 6-7.

(23) Rec. p. 16.

(24) Rec. p. 17.

(25) Appendix p. 27. This Court granted certiorari in this *Hoover* case and it is pending here as No. 486.

(26) Rec. p. 129.

favor because of the absence of the parties to the dissolved interferences.

4. The record shows that petitioners did not base their bill in equity upon the Patent Office ruling dissolving the interference[27]. The fact is that after the interference was dissolved, petitioners' application was remanded to the Examiner for *ex parte* prosecution[28], and during such *ex parte* prosecution a patent was refused by the Board of Appeals to petitioners on the ground that the application disclosure did not support the claims.[29] Petitioners based this bill in equity upon the action of the Patent Office Board of Appeals refusing them a patent[30] which took place on March 11, 1942, in the *ex parte* proceedings re-instituted by the Patent Office after the interferences were dissolved[31].

## Specification of Errors.

The errors which petitioners will urge if the petition for certiorari is granted, are that the Court of Appeals for the District of Columbia erred:

1. in holding that the District Court was without jurisdiction to hear this case where the jurisdictional facts admittedly exist;

2. in holding that rulings of the Patent Office before the refusal of a patent by the Board of Appeals deprived the District Court of jurisdiction of a case under Sec. 4915 where the jurisdictional facts concededly exist;

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(27) Rec. pp. 6-7.

(28) Rec. p. 5, Par. 15.

(29) Rec. pp. 5-6, Par. 16.

(30) Rec. pp. 5-7.

(31) Rec. p. 122; request for reconsideration denied April 13, 1942 (Rec. p. 125).

3. in holding that the District Court was deprived of jurisdiction of this controversy because of what the Patent Office tribunals may lawfully do after a decision in applicant's favor, notwithstanding the provisions of Patent Office Rule 116 and Section 4918 R. S.;

4. in denying to petitioners the remedy provided by Section 4915 of the Revised Statutes;

5. by affirming the District Court in its dismissal of the complaint on the holding that the disclosure of your petitioners' application did not support the claims sought, notwithstanding the uncontroverted evidence and testimony to the contrary; and

6. in affirming the judgment of the District Court dismissing petitioners' complaint.

## Summary of Argument.

The points of argument follow the reasons relied upon for the grant of a writ of certiorari, and are stated on pages 6 and 7 of the petition as well as in the index hereto. For the sake of brevity they are omitted at this point.

## ARGUMENT.

### POINT I.

**Substantially Identical Question Now Pending Before This Court.**

We have been informed that this Court granted certiorari in the case of *Hoover & Co.* v. *Coe*, 62 U. S. P. Q. 115, now pending in this Court as No. 486. The Court of Appeals of the District of Columbia decided the case at bar on the authority of that *Hoover* case. Therefore, this petition presents a question which is substantially identical with, or closely related to, matters already before this Court.

For these reasons, we respectfully urge this Court to grant this petition.

### POINT II.

**Decision Below Is Contrary to Long Established Construction of Section 4915 R. S.**

The Court of Appeals for the District of Columbia has misconceived the true meaning of Section 4915 of the Revised Statutes[32] and has construed it in a way which is contrary to the long standing construction given this statute by this Court, other Circuit Courts of Appeals and by the Patent Office.

In the case at bar it is admitted (1) that a patent on petitioners' application was refused by the Patent Office Board of Appeals; (2) that no appeal was taken to the

(32) Appendix 33.

Court of Customs and Patent Appeals; and (3) that the bill was filed within six months after such refusal.

Thus petitioners have brought themselves squarely within the provisions of this statute. Regardless of this, the Court of Appeals held that the District Court was without jurisdiction.

The court did this and denied petitioners the remedy afforded them by Section 4915 upon a newly devised erroneous theory. The court held that the District Court lacked jurisdiction of the instant case and assigned the following reasons:

1. A decision in petitioners' favor would constitute reversing an administrative ruling of no interference; and
2. An alleged absence of indispensable parties.

Neither of these reasons affords a sound basis for denying jurisdiction.

It is true that the Commissioner of Patents declared several interferences and later dissolved them. But petitioners did not file their bill in equity under Section 4915 based upon that dissolution. They could not do that, as that ruling did not constitute a refusal of a patent[33].

What petitioners did was to continue the *ex parte* prosecution of the application under the provisions of Patent Office Rule 116; your petitioner Schultz admittedly having been the senior applicant in the dissolved interferences. It was after they did that, that the Board of Appeals refused them a patent; and it was not until after such final refusal of a patent that they filed this suit.

The fact that the Board of Appeals assigned the same reason for refusing a patent as was given for dissolving the interferences does not deprive the District Court of

(33) *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. (2d) 847, 3rd Cir.

jurisdiction. The statute confers jurisdiction regardless of the reason for the refusal of a patent.

When a patent was refused them by the Board of Appeals, petitioners were entitled to their remedy under Section 4915. As they properly availed themselves of it, the District Court had jurisdiction.

It can make no difference in this case that previous to refusing a patent to petitioners, the Patent Office had dissolved the interferences, involving petitioners' application, upon the ground that this application did not support the claims if, at a later time, the Board of Appeals refused a patent to petitioners irrespective of whether the refusal was based upon the same ground or upon some other ground.

It was this last ruling, refusing a patent to petitioners, which brings this case within the provisions of Section 4915 and gives the District Court jurisdiction. Petitioners cannot be deprived of their statutory rights under Section 4915 merely because the court's ruling on the specific question presented might also show that some earlier unappealable administrative ruling was erroneous.

No administrative ruling upon a question during the early stages of the prosecution can deprive petitioners of their statutory rights under Section 4915, even though the ruling is upon identically the same basic question as is involved in the final decision of the Board of Appeals which brings the case within the statute.

When this distinction is kept in mind, it is clear that the other parties to the dissolved interferences are not even proper parties inasmuch as the final refusal of a patent to an applicant is an *ex parte* proceeding.

The Court of Appeals based its decision upon the erroneous assumption that if a decision is made in petitioners' favor, an interference must be declared. The court below

overlooked the provisions of Section 4904 of the Revised Statutes[34] which makes it *discretionary* with the Commissioner to declare interferences[35]. Furthermore, the Court of Appeals overlooked the fact that here it is admitted that petitioner Schultz is the first inventor of the subject matter disclosed in his application and that he was the senior party in the interferences.

Under Rule 116[36] of the Patent Office rules of practice, which was adopted by the Commissioner of Patents pursuant to Section 483 R. S. (U. S. C. title 35, Sec. 6), your petitioner Schultz, admittedly the Senior applicant of the previously dissolved Patent Office interferences, was entitled to a patent with all common patentable subject matter, including the claims here sought, without the necessity of the declaration of a further interference in the event the District Court below was reversed in its ruling. This is true even though, since the interference, a patent was issued to one of the other Junior applicants of said interference with the three claims here sought. This practice is in accordance with law, especially since Sec. 4918 R. S.[37] expressly provides for a Federal Court suit in the event conflicting patents are granted. To hold otherwise is to defeat the very purpose of Patent Office Rule 116 and Sec. 4918 R. S. The theory of this law is that once a Senior applicant has been in a Patent Office interference with a junior applicant the parties have had their day in Court, so to speak, in the Patent Office and any further contest between the parties should only be by way of a suit in equity under Sec. 4918 R. S.

The suggestion that there is an absence of indispensable parties implies that, under circumstances like those exist-

(34) Appendix 33.
(35) *Ewing* v. *Powler Car Co.*, 244 U. S. 1.
(36) Appendix 35.
(37) Appendix 35.

ing here, the District Court should try the issue of priority even though the Commissioner had previously decided that no interference in fact exists. This is imposing upon the District Court a duty of the Commissioner of Patents which the statute conferred exclusively upon him. Such a holding is in direct conflict with this Court's decision in *Ewing* v. *Fowler Car Co.*, 244 U. S. 1, where this Court held that Section 4904 R. S. commits to the opinion of the Commissioner the question of whether an interference exists and that that is a matter "not to be questioned except at the instance of the Commissioner by an exercise of judgment upon the circumstances." It also constitutes imposing a labor upon the District Courts—deciding priority questions in the first instance—not imposed by statute, which is a practice condemned by this Court in *Ex parte Harley Davidson Co.*, 259 U. S. 414, in the case of *pro forma* decrees.

Moreover, the legislative history of the Act makes it plain that, for over 100 years, Congress has had the policy of permitting an applicant who was refused a patent by the Patent Office tribunals, *for any reason whatsoever*, to have his asserted right to a patent for his invention determined *de novo* by a court of original jurisdiction, wholly distinct and independent from the Patent Office, *irrespective of whether thereafter the successful applicant may be required to comply with other requirements of law* before the patent is issued to him. (*Wettlaufer* v. *Robbins*, 92 F. (2d) 573, 575, 2nd Cir.)

This Court so construed this statute in *Gandy* v. *Marble*, 122 U. S. 432, where this Court held that a decision in applicant's favor "is to govern the action of the Commissioner" and that the statute does not authorize the Commissioner to issue a patent to the successful applicant unless he otherwise complies with law.

Before the decision of the Court of Appeals in the instant case, it was never questioned that Federal Courts had jurisdiction of bills in equity under Section 4915 in cases in which all possible proceedings in the Patent Office have not been completed. Jurisdiction was taken in *Pittman* v. *Coe*, 68 F. (2d) 412 (App. D. C.), where claims were rejected for improper joinder; in *International Cellucotton Co.* v. *Coe*, 85 F. (2d) 869 (App. D. C.), where claims were rejected on grounds of estoppel; in *Power Patents Co.* v. *Coe*, 110 F. (2d) 550 (App. D. C.), where claims were rejected because not supported by the application disclosure (the same ground as in the instant case); in *Tully* v. *Robertson*, 19 F. (2d) 954 (D. Md.), where the same rejection was made; in *Booth Fisheries Corp.* v. *Coe*, 114 F. (2d) 462 (App. D. C., c. d. 311 U. S. 691), where the rejection was the same as in the case at bar and the need for further proceedings was shown in the record but not reflected in the court's opinion; and in *Forward Process Co.* v. *Coe*, 116 F. (2d) 946 (App. D. C.), where the same rejection was made. Likewise suits under Section 4915 against the Commissioner have been frequently entertained where the rejection was based upon want of invention (*American Steel & Wire Co.* v. *Coe*, 115 F. (2d) 17 (App. D. C.); *Hydraulic Press Corp.* v. *Coe*, 124 F. (2d) 521, (App. D. C.); *Minn. Mining Co.* v. *Coe*, 125 F. (2d) 198 (App. D. C.), even though a ruling in plaintiff's favor may be and in some instances has been followed by further proceedings in the Patent Office resulting in depriving the successful party of a patent containing the claims allowed to him by the court. *Radtke Patents Corp.* v. *Coe*, 122 F. (2d) 937 (App. D. C.), *certiorari denied sub nom; Amer. Tri Ergon Corp.* v. *Radtke Patents Corp.*, 314 U. S. 695; *Poulsen* v. *Coe*, 119 F. (2d) 188 (App. D. C.); *Poulsen* v. *McDowell*, 142 F. (2d) 267 (C. C. P. A.). Also, it has been generally recognized by other Circuit

Courts of Appeal that the decision in applicant's favor under Section 4915 is merely declaratory and that the statute does not empower the Federal Courts to order the Commissioner to issue a patent because the successful party is required to comply with other requirements of law. *Phila. Storage Battery Co.* v. *Zenith Radio Corp.*, 117 F. (2d) 642, 645, 7th Cir.; *Cleveland Trust Co.* v. *Berry*, 99 F. (2d) 517, 520, 6th Cir.

The Patent Office tribunals have construed Section 4915 in the same way.

Thus in *Gold* v. *Newton, Comm'r*, 2nd Cir., 254 Fed. 824, the successful applicant in a suit under this statute was thereafter refused a patent by the Patent Office on new art. In *Radke Patents Corp.* v. *Coe*, 74 App. D. C. 251, 122 F. (2d) 937, the successful applicant in a suit under this statute was placed in interference by the Commissioner. And in *Cruickshank* v. *Strong*, 1880 C. D. 102, the Commissioner held that a successful party under this statute may be placed in interference. The Commissioner there held that a decision in applicant's favor in a 4915 suit disposes only of the question of patentability as between the applicant and the public and that (p. 103): "It cannot touch the question of priority of invention as between his application and any other pending application."

Thus for many years the Patent Office has construed this statute as giving it the right to proceed in accordance with other sections of the patent laws after a successful party in a 4915 suit filed a copy of the adjudication in his favor.

Orderly procedure demands that the established practice in the Patent Office be continued. Why should priority be investigated before the claims are found allowable? And if the Patent Office errs in setting up an interference and the error is pointed out by one of the parties, why should it be required to decide the question of priority when it is

of the opinion that no interference in fact exists? It appears better to follow the well settled Patent Office practice, that is—dissolve the interference and remand the case for further proceedings *ex parte*. Then, if the Board of Appeals refuses a patent, applicant is clearly entitled to the remedy given him by Section 4915.

The decision below overturns the long established construction of this statute in the Patent Office and unsettles Patent Office practice in examining applications and handling interferences.

In the light of the legislative history and the long established interpretation of this statute by this Court and other courts, it is clear that in holding that the District Court lacked jurisdiction of this case, the Court of Appeals has misconstrued this statute and has decided an important question of Federal law in a way that is in obvious conflict with the long established policy of Congress and with applicable decisions of this Court.

It is believed that all of the foregoing considerations warrant a review of the case by this Court.

## POINT III.

### Future Administration of Law May Be Seriously Hindered.

In the present case the Court of Appeals held that the District Court was without jurisdiction although the jurisdictional facts admittedly exist. But in prior decisions, where the effect of a decision in applicant's favor was exactly the same[38], the same court held that jurisdiction was present.

(38) Examples are:
*International Cellucotton Products Co.* v. *Coe*, 85 F. (2d) 869, App. D. C. 1936.
*Du Pont* v. *Coe*, 89 F. (2d) 679, App. D. C. 1937.
*American Cyanamid* v. *Coe*, 106 F. (2d) 851, App. D. C. 1939.
*Tomlinson of High Point* v. *Coe*, 122 F. (2d) 65, App. D. C. 1941.

Moreover, in a recent decision[39], where the facts were closely analogous, it held directly contrary to the holding in the case at bar, upon the ground that the Patent Office had not passed on the question of priority, which is true here. And in a decision handed down on the same day[40] the same court held that the District Court had jurisdiction and that the doctrine of *Hoover Co.* v. *Coe*, 62 U. S. P. Q. 115, does not clearly apply "because it may be • • • the record contains enough evidence to show that the plaintiff was prior in time without the necessity of further interference proceedings."

These conflicting decisions by the same Court of Appeals, on the question of jurisdiction of bills in equity under Section 4915, have created confusion on the matter and in the future Federal Courts will find it difficult, if not impossible, to ascertain whether they do or do not have jurisdiction.

For example, the case at bar, in its facts, is substantially the same as *Minn. Mining & Mfg. Co.* v. *Coe, supra.* Here, as there, the record contains enough evidence to show that plaintiff was prior in time without the necessity of further interference proceedings[41]. Yet the Court of Appeals held that the doctrine of *Hoover & Co.* v. *Coe, supra*, does *not* apply to the *Minn. Mining & Mfg. Co.* case but does apply here.

From the foregoing, it is clear that the judgment and opinion below will doubtless seriously hinder future administration of the law under this statute. As this Court has not passed upon the matter, it is urged to do so.

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(39) *Tomlinson of High Point* v. *Coe*, 123 F. (2d) 65.

(40) *Minn. Mining & Mfg. Co.* v. *Coe*, 62 U. S. P. Q. 119.

(41) Here it is admitted that petitioner Schultz is the first inventor of the subject matter disclosed in his application. The only question is whether the invention claimed in the claims in issue was disclosed in his application.

It will be seen also that in holding that the District Court lacked jurisdiction of the present case, where the jurisdictional facts are admittedly proved, the court imposed an entirely new condition—not demanded by the statute. The new condition is—that to give the court jurisdiction of such a case, it must not appear from the record that further interference proceedings may be necessary. By doing so, the court substituted its judgment for that of the Commissioner as to whether an interference may exist and has established a doctrine in conflict with Congressional policy in effect for over 100 years.

For these reasons, this question should be decided by this Court.

## POINT IV.

### It Was Error to Apply the Doctrine of the Hoover Case to the Case at Bar.

In its decision in the case at bar, the Court of Appeals stated that it affirmed the dismissal of the complaint upon the authority of *Hoover Co.* v. *Coe*, 62 U. S. P. Q. 115.[42]

We urge that the decision of the Court of Appeals in that Hoover case is clearly erroneous because it not only overturns a long established construction of Section 4915 R. S. by the Patent Office, but also is contrary to applicable decisions of this Court. However, even if this Court disagreed with our views regarding the Hoover case, we respectfully urge that the doctrine of that case should be limited to the facts there involved and should not be extended to the case at bar because here the facts differ in many material respects.

Thus in the *Hoover* case, counsel for the parties ad-

(42) Appendix 27.

mitted "that if plaintiff's claims are allowed, the court will be unable to declare that plaintiff is entitled to a patent because the record does not show that plaintiff made the prior discovery."

No such facts exist here. In the instant case, neither plaintiffs, nor their counsel, have admitted that the court will be unable to declare that plaintiffs are entitled to a patent. On the contrary, petitioners have steadfastly maintained that the court is able to and should, under the law and upon the facts here proved, declare that petitioners are entitled to a patent.

Furthermore, in the case at bar, the record conclusively establishes that petitioner, William O. Schultz, is the prior inventor. The Commissioner has admitted that Schultz is the first inventor of the subject matter disclosed in his application[43]. Therefore, the real issue was whether the invention defined by said claims 46, 48 and 49 was disclosed. On this subject, petitioners adduced testimony which stands uncontradicted.

In the present case, there is no question about the fact that this is an action under Section 4915 against the Commissioner alone for a declaration that petitioners are lawfully entitled to receive a patent. The parties so considered it, tried it on that basis, and the District Court so found[44]. That is another important distinction between this case and *Hoover Co.* v. *Coe, supra,* where "The only relief requested is a decree directing the Commissioner of Patents to find the claims are readable on plaintiff's disclosure and allowable to him provided that he later is determined to have priority."

In holding that this case is controlled by its decision in *Hoover & Co.* v. *Coe, supra,* where the facts were ma-

(43) Rec. pp. 2, 3, 9.

(44) Rec. p. 13.

terially different, the court has extended the doctrine of that case to a further illogical extreme. It has in effect held that an applicant, otherwise entitled to the remedy provided by Section 4915, must be denied that remedy unless he comes into court and tries out not only the issue of patentability, which is always present (*Hill* v. *Wooster*, 132 U. S. 693, 698), but also the issue of priority, which the Commissioner had held not to exist. In so deciding, the Court of Appeals overlooked the provisions of Section 4904 of the Revised Statutes and the decision of this Court in *Ewing* v. *Fowler Car Co.*, 244 U. S. 1, holding that only the Commissioner has power to declare whether or not an interference exists.

For these reasons, this matter should be reviewed by this Court.

POINT V.

**It Was Error to Disregard the Evidence That the Disclosure Is Sufficient to Those Skilled in the Art.**

The Court of Appeals also erred in affirming the dismissal of the complaint since the plaintiffs below offered uncontroverted testimony of a witness (found by the District Court to be one highly skilled in the art) that the subject matter of the claims in suit was inherent in the disclosure of the application and which was demonstrated by models found by the court to be unquestioned. The defendant offered no evidence other than the Patent Office record including the unsworn to statements of the Patent Office officials; it being apparently the custom of the Commissioner of Patents in defending suits under Section 4915 not to offer any testimony or new evidence to controvert the case of the plaintiff notwithstanding the fact that such a suit involves a trial *de novo*.

The District Court in deciding the case against your petitioners held with the rulings of the Patent Office even though the testimony offered by one skilled in the art to the contrary stood unrefuted. This was error since your petitioners contend that the defendant below made out no case at all and hence the proofs of plaintiffs below fully entitled them to a reversal of the Patent Office ruling.

## Conclusion.

Wherefore, petitioners earnestly pray that the petition for writ of certiorari be granted; the case be reviewed; and the judgment of the Court of Appeals for the District of Columbia be reversed.

Respectfully submitted,

CHARLES F. MERONI,
CARLTON HILL,
*Counsel for Petitioners.*

WILLIAM A. SMITH, JR.,
SAMUEL W. KIPNIS,
*Of Counsel.*

## APPENDIX.

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UNITED STATES COURT OF APPEALS

DISTRICT OF COLUMBIA.

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No. 8602.

The Hoover Company, Appellant,

v.

Conway P. Coe, Commissioner of Patent, Appellee.

Appeal from the District Court of the United States for the District of Columbia.

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Argued April 7, 1944. Decided July 10, 1944.

*Messrs. Richard R. Fitzsimmons* and *William D. Sellers*, with whom *Mr. William S. Hodges* was on the brief, for appellant.

*Mr. R. F. Whitehead*, with whom *Mr. W. W. Cochran*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before MILLER, EDGERTON and ARNOLD, Associate Justices.

ARNOLD, *Associate Justice:* Both parties to this suit claim that the sole issue involved is whether the patent claims set out in the complaint are supported by plaintiff's application. One of these claims has been copied from another patent. Others are substantially the same as the claims in the second patent, yet all of them were formulated for the express purpose of provoking interference proceedings in the Patent Office. All were rejected on the sole ground that they did not read on the disclosure of

plaintiff's application. In substance this meant that the Patent Office did not consider the patent with which plaintiff hoped to provoke an interference sufficiently similar to the patent from which the claims were copied to justify interference proceedings.

Counsel for both parties admit that if plaintiff's claims are allowed the court will be unable to declare that plaintiff is entitled to a patent because the record does not show whether plaintiff made the prior discovery. The only result will be to overrule the administrative decision that interference proceedings are not justified. The case will then be sent back to the Patent Office to determine priority. The complaint itself does not ask the court to adjudge that plaintiff is entitled to a patent. The only relief requested is a decree directing the Commissioner of Patents to find the claims are readable on plaintiff's disclosure and allowable to him provided that he later is determined to have priority.

On its own motion this court raised the question whether Section 4915 R. S. confers jurisdiction on the District Court to enter a decree which does not determine the right of the applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings. Both parties submitted memoranda of authority supporting the jurisdiction of the District Court in the above situation.

In the absence of controlling decisions it would seem clear from the statute that the District Court had no jurisdiction over this suit. The language of Section 4915 R. S. gives the court authority to adjudge that an applicant is entitled according to law to receive a patent for his invention as specified in his claim, or any part thereof, as the facts in the case may appear. Such an adjudication cannot be made in this case. Before plaintiff here is entitled to a patent it must establish priority over the patent from which the claims are copied. Such priority cannot be determined here for two reasons: (1) The party against whom the plaintiff claims priority is not before the court; (2) There has been no decision of priority by

the Board of Interference Examiners. The statute clearly indicates that the issue of priority can be heard in a suit in equity only when a patent has been refused by the Board of Appeals of the Patent Office or when the plaintiff is dissatisfied with a decision of the Board of Interference Examiners.

In substance, this case is not a suit on the merits but an appeal from the refusal of the Patent Office to take preliminary steps which would lead to interference proceedings. Sections 4911 and 4914 R. S. give the United States Court of Customs and Patent Appeals jurisdiction to correct an administrative ruling of the Patent Office for error appearing on the Patent Office record. Nothing in Section 4915 R. S. indicates that a suit in equity tried on new evidence is a duplicate method of reviewing an administrative ruling in a case where the plaintiff's right to a patent cannot be determined. Furthermore, consideration of sensible and orderly procedure are against this construction. The idea that a court of equity should interfere with the proceedings of an administrative tribunal by a trial *de novo* at a stage when no decision on the merits can be given is contrary to the fundamental concept of equity jurisdiction.

Turning now to the cases we find an explicit ruling by the Supreme Court that a proceeding under Section 4915 R. S. cannot select a single issue which affects plaintiff's right to a patent, without determining all the other issues on which that right depends. The Court said:

> "The provision of section 4915 is that the circuit court may adjudge that the applicant 'is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear;' and that, if the adjudication is in favor of the right of the applicant, it shall authorize the commissioner to issue the patent. *It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill cannot be concluded by solely determining an is-*

*sue as to which of them in fact first made a cabinet creamery.* A determination of that issue alone, in favor of the applicant, *carrying with it, as it does, authority to the commissioner to issue a patent to him for the claims in interference,* would *necessarily* give the sanction of the court to the patentability of the invention involved." (Italics added.)[1]

Our own decision in *Radtke Patents Corporation* v. *Coe*[2] is to the same effect.

In the case before us we cannot determine plaintiff's right to a patent because it involves deciding that he is prior in time to another applicant who is not a party to the suit. Since the court cannot decide the whole controversy on its merits we have no jurisdiction over the intermediate proceedings in the Patent Office.[3]

The notion that an equity suit under Section 4915 R. S. gave jurisdiction to authorize the issuance of a patent to a party where the issue of priority could not be determined stems from the case of *Pitman* v. *Coe*.[4] In that case the Commissioner moved to dismiss a proceeding under Section 4915 R. S. because the denial of plaintiff's claim by the Patent Office was based on improper joinder of claims in one application. The Commissioner argued that since patentability was yet to be determined, the order refusing the claims was interlocutory and not final. No

1. *Hill* v. *Wooster*, 132 U. S. 693, 698 (1890).

2. 74 App. D. C. 251, 122 F. (2d) 937 (1941). In *Butterworth* v. *United States ex rel. Hoe*, 112 U. S. 50, 61 (1884), it was indicated that the record in a suit under Section 4915 R. S. should include the whole merits of the applicant's right to a patent. The court said: "It is thereby provided (referring to R. S. 4915) that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in Section 4911, confined to the case as made in the record of that office, but it is prepared and heard upon all competent evidence adduced *and upon the whole merits.* Such has been the uniform and correct practice in the circuit courts. *Whipple* v. *Miner*, 15 Fed. Rep. 117; *ex parte* Squire, 3 Ban. and A., 133; *Butler* v. *Shaw*, 21 Fed. Rep. 321." (Parenthetical matter and italics added.)

3. Cf. *Synthetic Plastics Co.* v. *Ellis-Foster Co.*, 78 F. (2d) 847 (C. C. A. 3rd, 1935); *Cherry-Burrell Corp.* v. *Coe*, No. 8487 (decided June 19, 1944).

4. 62 App. D. C. 305, 68 F. (2d) 412 (1933).

question of priority was involved and all the necessary parties were before the court. The court declared that the refusal of a patent claim based on an order of division could be reviewed by a suit in equity. The prayer of the complaint asked for the issuance of a patent and not for a limited review of the order of division by itself. It is, therefore, not clear from the decision whether the court thought that the District Court had authority to review the single question of division and send the case back to the Patent Office for determination of patentability or whether it considered the trial court had the power to conduct an original hearing on patentability. If the decision be construed as holding that the issue of patentability need not be decided in a Section 4915 R. S. proceeding it is inconsistent with the Supreme Court's ruling in *Hill* v. *Wooster* and has been overruled by our decision in *Radtke Patents Corp.* v. *Coe*. If it be construed as authorizing the District Court to decide the question of patentability before the Patent Office has determined that issue, it sets forth a highly questionable doctrine which in effect transfers to the court the duty of the Patent Commissioner[5] to make an original expert investigation of the prior art. But even if we followed the dubious course of allowing the District Court to make an original investigation of priority before the Patent Office acted, there would be no jurisdiction here because the holder of the interfering application or patent would be an indispensable party.[6]

5. Section 4904 R. S.

6. *Hazeltine Corp. v. White*, 68 F. (2d) 715 (C. C. A. 2d, 1934). That case was a suit by a losing party in a multiple interference proceeding, brought against the successful interferent. It was held that the other losing interferents were indispensable parties to a suit under Section 4915 R. S. The court said, at page 717: "Only in the sense that a decree in this suit would be futile to establish the right of any one to a patent, on the assumption that the Commissioner would not be authorized to issue it, can it be said that a decree can be made which does not affect the interests of the absent adverse parties. . . . A decree which did authorize the Commissioner to issue the patent would ignore the right of the absent adverse parties to be heard, and leave the controversy in such a condition that its final determination might be contrary to fundamental principles of equity and good conscience."

If, as the statute requires, this court were to issue a decree adjudging that the plaintiff is entitled to the claims in issue, it would likewise "ignore the right of the absent adverse parties to be heard." That the rival claimant is an adverse party and that the issue of readability may be the most crucial one in his case is illustrated by *Smith* v. *Carter Carburetor Corp.*, 130 F. (2d) 555 (C. C. C. 3rd, 1942).

Appellant asserts that this court has tacitly approved administrative review of Patent Office rulings under Section 4915 R. S. in cases where the record showed that the claims involved were copied from other patents or applications to provoke interference proceedings. It cites the cases of *International Cellucotton Products Co.* v. *Coe*[7] and *American Cyanamid Co.* v. *Coe*.[8] Those cases involved the refusal to grant claims copied from another patent. Nevertheless, the mandate directed the Patent Office to issue a patent to the plaintiff. The Patent Office was unable to comply because priority had not been determined. The mandate was, therefore, ignored and interference proceedings were instituted after our decision. The question of jurisdiction was not raised by the Patent Office or considered by this court. Our attention was not called to the fact that the mandate in favor of plaintiff's right to a patent could not be carried out. Instead of supporting jurisdiction the unforeseen results of these cases illustrate the inappropriateness of an independent suit in equity to determine the correctness of an intermediate ruling in the Patent Office. They present a procedure in which a court of equity makes a declaratory judgment on a record which compels the Patent Office to ignore the terms of that judgment.

Doubtless the failure of this court to notice the lack of jurisdiction in the cases above referred to was due to the artificial form in which they were presented. Theoretically each patent claim is a distinct invention. Therefore, the refusal of any single claim appears in the pleadings under Section 4915 R. S. as the refusal of a patent on a distinct invention. Actually, however, in applications containing multiple claims the claims often do not represent distinct inventions but only different ways of describing a single invention. This is particularly true when claims are copied to be used as counts in an interference. The purpose of such copied claims is not to claim distinct inventions but to compare similar single inventions detail by detail. This method of limiting or enlarging the scope

7. 66 App. D. C. 248, 85 F. (2d) 869 (1936).
8. 70 App. D. C. 330, 106 F. (2d) 851 (1939).

of a single invention through the device of multiple claims should be recognized for what it is,—an administrative method by which the Patent Office clarifies the issues in an interference proceeding. The fact that the Patent Office uses an artificial conception of the phrase "distinct invention" should not be made a vehicle to enlarge the jurisdiction of this court to include appeals which may properly be taken only to the United States Court of Customs and Patent Appeals.

For these reasons the judgment of the court below dismissing the complaint will be

*Affirmed.*

**Statutes:**

SEC. 4904. R. S. (U. S. C., title 35; sec. 52.) Whenever an application is made for a patent which, in the opinion of the Commission, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commission may issue a patent to the party who is adjudged the prior inventor. [As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, infra.]

*Act of Aug. 5, 1939, 53 Stat. 1212:*

SEC. 5. This Act [amending sections 4904, 4909, 4911, and 4915 of the Revised Statutes (U. S. C., title 35, secs. 52, 57, 59a, and 63)] shall take effect two months after its approval; but it shall not affect interferences then pending, which may be heard and decided and appeals and other proceedings taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended.

SEC. 4915. R. S. (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, un-

less appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appeal. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. [As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, printed after R. S. Sec. 4904, *ante*.]

*Act of Mar. 3, 1927, 44 Stat. 1394 (U. S. C., title 35, sec. 72a)*:

And upon the filing of a bill in the District Court of the United States for the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes (U. S. C., title 35, sec. 63 or sec. 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or ad-

verse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (sec. 113 of title 28 U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

SEC. 4918. R. S. (U. S. C., title 35, sec. 66.) Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void in whole or in part upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

**Rules of Practice:**

116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject-matter of his application shall not be deprived of any claim to such subject-

matter solely on the ground that such claim was not added to the interference by amendment under rule 109.

122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact and also motions to shift the burden of proof, should contain a full statement of the ground relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

At a hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. The matter raised on a motion to shift the burden of proof may be reviewed at final hearing.